

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit No.: 3623

Franklin Grosvenor, et al.

Examiner: JEANTY, ROMAIN

Serial No.: 09/846,134

Filed on: April 30, 2001

For: METHOD AND APPARATUS PROVIDING A
SUPPLY CHAIN MANAGEMENT SYSTEM
USEFUL IN OUTSOURCED
MANUFACTURING

Mail Stop Issue Fee
Commissioner of Patents
P.O. Box 1450
Washington, D.C. 20231

PETITION TO THE DIRECTOR TO REVIEW
AND RESCIND A FINAL RESTRICTION REQUIREMENT
Under 37 CFR 1.144 and 37 CFR 1.181(a)

Sir:

The first Office Action mailed April 27, 2005 presented a restriction requirement to elect a single disclosed species for prosecution.

Applicant timely requested reconsideration of the restriction requirement on May 9, 2005 and withdrew Claims 6-18 with traverse, in a response to the first Office Action.

The second Office Action mailed August 11, 2005 made the restriction requirement final with respect to Claims 6-11 and 13-18.

Pursuant to 37 CFR 1.144 and 37 CFR 1.181(a), Applicant respectfully requests that the Director review and rescind the final restriction requirement.

I. ELECTION REQUIREMENT FAILS TO MAKE A SHOWING OF A BURDEN

The MPEP repeatedly states that a fundamental criterion for a proper requirement of restriction is that there “must be a serious burden on the examiner if restriction is required ... if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” *See* MPEP 803. However, the Office Action makes no showing of any burden on the Examiner, much less a serious burden.

No serious burden exists in this case. The first Office Action gives no indication that the subject matter of Claims 6-11 and 13-18 is separately classified, separately recognized in the art, or that the claims are so numerous or complex as to require a seriously burdensome search or other substantive examination. A search for art pertaining to automated application supply chain rules is likely to uncover any prior art that could possibly be pertinent to Claims 6-11 and 13-18. Indeed, with the automated, keyword-based search tools available to Examiners, and the high level of skill among Examiners, searching or opining on Claims 6-11 and 13-18 cannot present any serious burden. The present application contains a reasonable number of claims. Therefore, the amount of time required for search or substantive examination does not represent a serious burden.

Moreover, the first Office Action makes no attempt to present any substantive rationale as required by MPEP 816, or under the outline provided in MPEP 817. The only rationale given in the first Office Action is two conflicting statements of the generic feature. In section (1.), the first Office action states that Claims 6-18 “are distinct species of the generic feature of wherein periodically applying rules comprises.” In Section (2.), second paragraph, the first Office Action states that the claims “are distinct species of the generic feature of wherein periodically applying rules comprises escalating comprises.” These statements conflict, and the latter is not

understandable because neither Claim 1 nor Claim 5 (from which Claims 6-18 depend) contain a reference to “escalating.” The statements are also conclusory and do not meet the standard of MPEP 816-817.

In response to Applicant’s above argument, the second Office Action merely notes that the term “escalating comprises” was an inadvertent typos in the first Office Action but provides no supporting rationale except reiterating that, because Claims 6-11 and 13-18 recite different set of limitations, a burden has been posed on the Examiner. The Office Actions fail to state what limitations in the claims present a serious burden for examination.

However, the fact that the claims in the application may recite different limitations, as they are expected to do, does not free the Office from meeting its responsibility to articulate a supporting rationale for the restriction requirement. *See In re Kase*, 71 USPQ2d 1063 (PTO Dir. 2004) (unpublished). In fact, the failure of articulating a supporting rationale is enough to establish that the election requirement has been made in error. The absence of a supporting rationale also tends to establish that the subject matter of Claims 6-11 and 13-18 is easily examined at the same time. Applicants are not, by this statement, contending or admitting that Claims 6-11 and 13-18 are not patentably distinct. Applicants respectfully submit, however, that the failure of the Office Action to present a **substantive technical or administrative reason** for election is an admission that election is not proper, and that all the claims are easily examined together.

In addition, a heavy burden falls on the Applicants if the election requirement is maintained. An election requirement that could potentially require Applicants to file twelve (12) additional applications, one for each of Claims 6-11 and 13-18 that is not elected herein imposes an unreasonable resource burden on the Applicants, and would lead to a needless compounding of Office resources.

For all the foregoing reasons, reconsideration and withdrawal of the election requirement are respectfully requested.

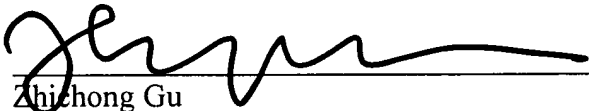
II. CONCLUSIONS & MISCELLANEOUS

A law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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Dated: March 19, 2007


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On March 19, 2007 By Martina Placid